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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/422,339
Filing Date: October 21, 1999
Appellant(s): WOOLSTON ET AL.

AUG 20 2007

GROUP 3600

John C. Phillips
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/14/2007 appealing from the Office action mailed 11/1/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 2/1/2007 has been entered per the "Notice of Panel Decision from Pre-Appeal Brief Review" mailed on 3/27/2007.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

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(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2006/0074792	Wagoner et al.	04/06/1996
6,133,912	Montero	10/17/2000
6,697,824	Bowman-Amuah	02/24/2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 49-66 are rejected under 35 U.S.C. 101.
- Claims 1, 3-5, 10-27, 29-49 and 51-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagoner et al. in view of Montero.
- Claims 2, 6-9, 28 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagoner et al. in view of Montero and further in view of Bowman-Amuah.

A copy of the rejection presented in the Office action mailed 11/1/2006 is provided below:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 49-66 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter.

Referring to claims 49-66. Claim 49 is directed to computer software, embodied in a tangible medium or in a propagated carrier signal or both. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional

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descriptive material falls within any of the categories of patentable subject matter set forth in §101.

Claims 50-66 are dependent upon claim 49.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 10-27, 29-49 and 51-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagoner (U.S. Patent Application Publication 2006/0074792) in view of Montero (U.S. Patent No. 6,133,912).

Referring to claim 1. Wagoner discloses an computer-implemented method for encouraging users of a computer network to access dynamic pricing information on the computer network, the method comprising:

- Distributing over the computer network to a first user of the computer network a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network (Wagoner: at least paragraph 0024, "...displaying one or more auction data for the one or more identified auctions in a scrolling ticker on a user terminal, the one or more auction data is a hypertext link to a first web page associated with the action data.");
- Receiving from the first user input identifying selected dynamic pricing information (Wagoner: at least paragraph 0101: "The program reads the text strings contained in the text file, and displays the text string contents in a scrolling ticker as a selectable hypertext link enabling access to a web page addressed by the associated URL."); and

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- Communicating the dynamic pricing information selected by the first user to a second user for display at a modular computer program, executing on a computer system associated with the second user, that displays to the second user a stream of dynamic pricing information (Wagoner: at least 0103: "In another embodiment, the auction data may be displayed on a vehicle dealer terminal. The auction data may advantageously be stored on one or more storage mediums **108**. The vehicle dealer terminal is a terminal used by a vehicle dealer to access the Data Center system.").

Wagoner does not expressly disclose presenting to the first user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program. Montero discloses presenting to the first user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program (Montero: at least column 4, line 63 to column 5, line 12). Montero discloses a method wherein INFO servers continuously transmit information such as advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates and like, to form a sequence of information. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Wagoner to have included the teachings of Montero as discussed above in order to continuously display information without interfering with the display of selected data (Montero: at least column 3, lines 21-23).

Referring to claim 3. Wagoner further discloses a method comprising collecting dynamic pricing information from the computer network (Wagoner: at least paragraph 0024).

Referring to claim 4. Wagoner further discloses a method wherein the computer network comprises the Internet (Wagoner: at least paragraph 0049).

Referring to claim 5. Wagoner further discloses a method wherein the computer network comprises a virtual private network (Wagoner: at least paragraph 0024).

Referring to claim 10. Wagoner further discloses a method comprising causing the modular computer program to display the stream of dynamic pricing information collected from the computer network (Wagoner: at least paragraph 0024).

Referring to claim 11. Wagoner further discloses a method wherein the stream of dynamic pricing information that is displayed varies based on user input (Wagoner: at least paragraph 0024, "...identifying the one or more auctions that satisfy the one or more filtering parameters.").

Referring to claim 12. Wagoner further discloses a method wherein the stream of dynamic pricing information has a predetermined taxonomy, and wherein the user can selectively view different levels of the taxonomy (Wagoner: at least paragraph 0099).

Referring to claim 13. Wagoner further discloses a method wherein the interactive visual indication comprises a glyph (Wagoner: at least paragraph 0101: "The program reads the text strings contained in the text file, and displays the text string contents in a scrolling ticker as a selectable hypertext link enabling access to a web page addressed by the associated URL.").

Referring to claim 14. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method wherein the interactive visual indication comprises an interactive link to the user-attractive resource (Montero: at least column 4, line 63 to column 5, line 42)

Referring to claim 15. Wagoner in view of Montero discloses a method according to claim 14 as indicated supra. Montero further discloses a method wherein the interactive link comprises a uniform resource locator tag (Montero: at least column 5, lines 60 to column 6, line 6)

Referring to claims 16-19. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method wherein the user-attractive resource comprises advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates and like, to form a sequence of information (Montero: at least column 4, line 63 to column 5, line 12). Montero does not explicitly state that the advertisement (one of many user-attractive resources) type takes the form of a contest, a reward program or a coupon. However, the type of advertisement is claimed utilizing a "wherein clause" that does not relate back to or clarifies what is required by the claims. The wherein clauses of claims 16-19 merely states the result of a limitation in the claims and is therefore given little

patentable weight. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Referring to claim 20. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method wherein the user-attractive resource comprises a multi-media presentation (Montero: at least column 4, line 63 to column 5, line 12).

Referring to claim 21. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Montero further discloses a method comprising providing a user with access to the user-attractive resource upon sensing that the user selected the interactive visual indication (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claim 22. Wagoner further discloses a method wherein the modular computer program displays dynamic pricing information in a ticker display format (Wagoner: at least paragraph 0024).

Referring to claim 23. Wagoner further discloses a method wherein a plurality of instances of the modular computer program are presented to a user concurrently (Wagoner: at least paragraph 0024).

Referring to claim 24. Wagoner in view of Montero discloses a method according to claim 23 as indicated supra. Montero further discloses a method wherein each of the plurality of instance of the modular computer program includes one or more associated visual indications of a user-attractive resource available on the computer network (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claim 25. Wagoner in view of Montero discloses a method according to claim 24 as indicated supra. Montero further discloses a method wherein each of the one or more visual indicators can be the same as or different from the visual indications on other instances of the modular computer program (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claim 26. Wagoner in view of Montero discloses a method according to claim 24 as indicated supra. Montero further discloses a method wherein each of the one or more visual indicators can correspond to the same or different user-attractive resources as the visual indications on other instances of the modular computer program (Montero: at least column 4, line 63 to column 5, line 42).

Referring to claims 27 and 29-47. The limitations of claims 27 and 29-47 closely parallel those of claims 1, 3-5 and 10-26. Claims 27 and 28-47 are rejected under the same rationale as set forth above in claims 1, 3-5 and 10-26.

Referring to claim 48. The limitations of claim 48 closely parallel those of claim 1. Claim 48 is rejected under the same rationale as set forth above in claim 1.

Referring to claims 49 and 51-66. The limitations of claims 49 and 51-55 closely parallel those of claims 1, 3-5 and 10-26. Claims 49 and 51-66 are rejected under the same rationale as set forth in claims 1, 3-5 and 10-26.

Claims 2, 6-9, 28 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagoner (U.S. Patent Application Publication 2006/0074792) in view of Montero (U.S. Patent No. 6,133,912) in further view of Bowman-Amuah (U.S. Patent No. 6,697,824).

Referring to claims 2, 28 and 50. Wagoner in view of Montero discloses a method, system and product according to independent claims 1, 27 and 49 as indicated supra. Neither Wagoner nor Montero disclose wherein the modular computer program comprises a Java-based applet. Bowman-Amuah discloses wherein a modular computer program comprises a Java-based applet (Bowman-Amuah: at least column 10, lines 12-21).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above in order to improve client side performance (Bowman-Amuah: at least column 10, lines 12-21).

Referring to claim 6. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Bowman-Amuah discloses a method comprising pushing a copy of a modular computer program to one or more users of the computer network (Bowman-Amuah: at least column 37, lines 15-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the

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teachings of Bowman-Amuah as discussed above in order to enable an enterprise to reach and provide value to their customer outside of the traditional interactions (Bowman-Amuah: at least column 37, lines 24-35).

Referring to claim 7. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Bowman-Amuah discloses wherein distributing a modular computer program comprises enabling users of the computer network to pull a copy of a modular computer program (Bowman-Amuah: at least column 74, lines 19-29).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above in order to enable an enterprise to reach and provide value to their customer outside of the traditional interactions (Bowman-Amuah: at least column 37, lines 24-35).

Referring to claims 8-9. Wagoner in view of Montero discloses a method according to claim 1 as indicated supra. Bowman-Amuah discloses wherein distributing a modular computer program comprises sending the modular computer program to a user of the computer network through an electronic mail system and an instant messaging system (Bowman-Amuah: at least column 53, lines 27-35).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method, system and product of Wagoner in view of Montero to have included the teachings of Bowman-Amuah as discussed above in order to enable an enterprise to reach and provide value to their customer outside of the traditional interactions (Bowman-Amuah: at least column 37, lines 24-35).

(10) Response to Argument

Rejections under 35 U.S.C. 101

The Appellant argues that the amendment to claim 49 should have been entered because it merely obviates the 101 rejections and does not raise new issues.

The Examiner notes, the Appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The amendment after final rejection filed on 2/1/2007 has been entered per the "Notice of Panel Decision from Pre-Appeal Brief Review" mailed on 3/27/2007, and therefore Appellant's arguments are moot.

However, in light of the entered amendment after final rejection, the rejection of claims 49-66 under 35 U.S.C. 101 as being directed towards non-statutory subject matter is maintained. After entry, claim 49 is directed to computer software, embodied in a tangible medium. The specification as originally filed (page 22) describes a medium, "...as a high speed backbone that may support point-to-multipoint transmission..." Since the Appellant provided an explicit definition of what constitutes a medium in the specification, and because said definition is directed to a form of energy, a rejection under 35 U.S.C. 101 is proper. O'Reilly, 56 U.S. (15 How.) at 112-14. USPTO personnel are to give claims their broadest reasonable interpretation in light of

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the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Rejections under 35 U.S.C. 103(a)

The Appellant argues that the proposed combination of Wagoner and Montero fails to disclose or suggest each and every element of claim 1, in particular, communicating the dynamic pricing information selected by the first user for display at a modular computer program.

The Examiner notes, Wagoner discloses a method wherein a user, having logged on to a auction center, can request the auction center to display a scrolling ticker (i.e, dynamic pricing information) containing auction data. The user may specify one or more parameters that can be used in filtering the content of the scrolling ticker (Wagoner: paragraph 0102). Wagoner further teaches that the scrolling ticker may advantageously be implemented utilizing the freeware program "ticker.class" (i.e., a modular computer program) (Wagoner: paragraph 0101).

The Appellant argues that the references are silent as to whether the dynamic pricing information selected by the first user is communicated to a second user for display at a modular computer program as recited in claim 1.

Wagoner discloses a method wherein auction data may be displayed across multiple terminals, including a buyer's terminal and a vehicle dealer's terminal. The vehicle dealer's terminal is used by a vehicle dealer to access a pool of information stored in a Data Center system. The Data Center system can feed to a vehicle dealer a scrolling ticker containing auction data regarding one or more active auctions (Wagoner:

paragraph 0103 and Figure 1). Therefore, multiple networked computers have simultaneous access to the same dynamic data.

As acknowledged by the Appellant on page 8 of the brief, Wagoner discloses an alternate remote location for viewing auction data. However, the Appellant insist that this functionality discloses nothing about a relationship between the data and the first user.

The Examiner notes, the language of claim 1 merely requires a first user to select certain information to receive, followed by a circumstance wherein the same information could be separately communicated to a second user. However, the claims do not require the first user to actively select information and send said selected information to the second party. There is no required relationship pertaining to the data and the first user set forth in the claims.

The Appellant argues that Montero is silent as to whether the information is visually embedded within the stream of dynamic pricing information, as recited in claim 1.

The Examiner notes, Montero discloses a method wherein INFO servers continuously transmit information such as advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates and like, to form a sequence of information (Montero: column 4, line 63 to column 5, line 12). This sequence of information is transmitted together and continuously (i.e., mutually embedded). At the time the invention was made, it would have been obvious to a

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person of ordinary skill in the art to have modified the method of Wagoner to have included the teachings of Montero as discussed above in order to continuously display information without interfering with the display of selected data (Montero: at least column 3, lines 21-23).

The Applicant argues that Bowman-Amuah fails to disclose or suggest the claimed Applet computer program capable of receiving dynamic pricing information, displaying the received dynamic pricing information, receiving from the first user information, sending the received selection information, and presenting to the second user as recited in claims 1-2, 27-28 and 49-50.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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